

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-45 are pending in the application, with 1, 13, 16, 28, 31, 36, and 41 being the independent claims. Claims 1-4, 8, 13, 31, and 41 are amended. Claim 8 is amended merely to correct antecedent basis due to a typographical error. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 101

In paragraph 2 of the Office Action, claims 1-15, 31-35, 41, and 43-45 were rejected under 35 U.S.C. § 101, "because said claim is directed to non-statutory subject matter." Without acquiescing to the propriety of this rejection, Applicants have amended claims 1, 13, 31, and 41 as shown above, to overcome the rejection. Furthermore, claims 2-4 are amended to correct antecedent basis, in light of the amendments to claims 1, 13, 31, and 41.

As shown above, claims 1, 31, and 41 have been amended to recite methods that produce a concrete, tangible and useful result. The preamble of claim 1 has been amended to recite "a computer implemented method", and the body of claim 1 has been amended to include "conditionally forwarding the at least one pre-populated field to an

entity associated with the advertisement to provide information regarding the user to the entity" (emphasis added). Claim 31 (shown in part) has been amended as follows:

"wherein the device displays the plurality of advertisements in a rotational fashion and enables the user to interact with the displayed advertisements." Claim 41 (shown in part)

has been amended as follows: "enabling the display of the selected advertisements on said mobile device and the interaction of a user with the displayed advertisements." As stated in the M.P.E.P., "[a] claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452." M.P.E.P. sec. 2106 IV.(B)2.(b)(ii) (emphasis added).

Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Rejections under 35 U.S.C. § 103

In paragraph 3 of the Office Action, claims 1-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable U.S. Patent No. 6,219,696 to Wynblatt *et al.* (hereinafter Wynblatt. Applicants respectfully traverse the rejection of these claims.

Claims 1-12 and 16-27

The Office Action fails to establish a *prima facie* case of obviousness for at least the reason that Wynblatt fails to teach each and every feature of the claimed embodiments of the claimed invention, including claim 1. (M.P.E.P. § 2143).

Wynblatt teaches transmitting URLs (Uniform Resource Locators) to mobile information terminals from local agents such as billboards (*see* Abstract; *see also* col. 2,

lines 35-48). A mobile information terminal receives a URL from a local agent. The URL can have placeholder variables. The mobile information terminal fills in the placeholder variables with values. The mobile information terminal requests from the Internet a webpage corresponding to the URL. A program at a WWW server on the Internet takes as parameters the values in the placeholders to generate information to place in the webpage. (col. 5, lines 9-33). The mobile information terminal then receives and displays the webpage.

Wynblatt is very different from the claimed embodiments of the present invention. Claim 1, as amended, is shown below:

1. A computer implemented method for placing advertisements with interactive content on devices, comprising the steps of:
 - (1) displaying an advertisement with interactive content on a device;
 - (2) pre-populating at least one field of the advertisement with address location information relating to the user of the device; and
 - (3) conditionally forwarding the at least one pre-populated field to an entity associated with the advertisement to provide information regarding the user to the entity.

As recited in claim 1, the mobile device prepopulates at least one field of the advertisement with address location information relating to the user of the device, and conditionally forwards the at least one pre-populated field to an entity associated with the advertisement. In contrast, Wynblatt describes a mobile information terminal filling in placeholder variables in a URL with values, and requesting a webpage corresponding to the URL. Thus, Wynblatt does not prepopulate at least one field of an advertisement, and does not conditionally forward the at least one pre-populated field to an entity

associated with the advertisement. Therefore, Wynblatt does not teach or suggest each and every element of claim 1.

Thus, for at least this reason, claim 1 is patentable over Wynblatt. Furthermore, independent claim 16 is also patentable over Wynblatt for at least these reasons, and further in view of its own features. Furthermore, dependent claims 2-12 and 17-27, which depend from claims 1 and 16, respectively, are also patentable over Wynblatt for at least these reasons, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 1-12 and 16-27 be reconsidered and withdrawn.

Applicants note that the Examiner took "Official Notice" that the concepts and the advantages of the elements and limitations of claims 2-6 (pages 5-6 of the Office Action) and claims 7-12 (pages 6-7 of the Office Action) "were notoriously well known and expected in the art at the time of the invention" Applicants respectfully traverse these assertions of Official Notice by the Examiner.

Applicants have reviewed the statements in the Office Action regarding claims 2-6 and 7-12, and have found them unclear and unsupported. Applicants respectfully request that if these assertions are maintained in a next Office Action, that the Examiner clarify his remarks regarding the modification of Wynblatt, the reasons for the motivation thereof, and how they apply to claims 2-6 and 7-12, so that Applicants can have the opportunity to timely respond. Applicants also respectfully request that the Examiner provide documentary evidence in the next Office Action to support his assertion of Official Notice if the assertion is to be maintained, as required in M.P.E.P. § 2144.03(C.). *See* 37 C.F.R. § 1.104(c)(2). *See also Zurko*, 258 F.3d at 1386, 59

USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test).

Claims 13-15 and 28-30

The Office Action fails to establish a *prima facie* case of obviousness for at least the reason that Wynblatt fails to teach each and every feature of claim 13. (M.P.E.P. § 2143). Wynblatt is very different from the claimed embodiments of the present invention. Claim 13, as amended, is shown below:

13. A method for providing content specific advertisements to mobile devices, comprising the steps of:
- (1) accessing a user profile associated with a user of a device;
 - (2) identifying one or more of a location of the device and a time of day;
 - (3) selecting one or more advertisements based on one or more of the user profile, the location of the device, and the time of day; and
 - (4) transmitting the advertisements selected in step (3) to the device to enable the user of the device to interact with the advertisement on the device.

As described above, Wynblatt teaches a local agent 28 (such as a billboard) that transmits a URL to mobile information terminals (*see* Abstract; *see also* col. 2, lines 35-48). Wynblatt states the system "provides drive-by-access" (col. 2, lines 26-27).

Wynblatt does not teach or suggest accessing a user profile associated with a user of a device, as recited in claim 13. Wynblatt merely teaches transmitting a URL to mobile information terminals that are passing by. Thus, Wynblatt has no need for accessing a user profile (as recited in claim 13), as it does not discriminate as to whom it transmits the URL. Therefore, contrary to the assertion in the Office Action, a motivation to modify Wynblatt to include "accessing a user profile associated with a user of a device"

is not present, and Wynblatt actually teaches away from claim 13. Therefore, Wynblatt does not teach or suggest each and every element of claim 13.

Thus, for at least this reason, claim 13 is patentable over Wynblatt. Furthermore, independent claim 28 is also patentable over Wynblatt for at least these reasons, and further in view of its own features. Furthermore, dependent claims 14-15 and 29-30, which depend from claims 13 and 28, respectively, are also patentable over Wynblatt for at least these reasons, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 13-15 and 28-30 be reconsidered and withdrawn.

Applicants note that the Examiner took "Official Notice" that the concepts and the advantages of the elements and limitations of claims 14-15 (page 9 of the Office Action) and claims 29-30 (page 10 of the Office Action) "were notoriously well known and expected in the art at the time of the invention" Applicants respectfully traverse these assertions of Official Notice by the Examiner.

Applicants have reviewed the statements in the Office Action regarding claims 14-15 and 29-30, and have found them unclear and unsupported. Applicants respectfully request that if these assertions are maintained in a next Office Action, that the Examiner clarify his remarks regarding the modification of Wynblatt, the reasons for the motivation thereof, and how they apply to claims 14-15 and 29-30, so that Applicants can have the opportunity to timely respond. Applicants also respectfully request that the Examiner provide documentary evidence in the next Office Action to support his assertion of Official Notice if the assertion is to be maintained, as required in M.P.E.P. § 2144.03(C.). See 37 C.F.R. § 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59

USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test).

Claims 31-40

The Office Action fails to establish a *prima facie* case of obviousness for at least the reason that Wynblatt fails to teach each and every feature of claim 31. (M.P.E.P. § 2143). Wynblatt is very different from the claimed embodiments of the present invention. Claim 31, as amended, is shown below:

31. A method for dynamic advertisement rotation on a mobile device, comprising the steps of:
(1) identifying a plurality of advertisements; and
(2) downloading the plurality of advertisements to a user's device wherein the device displays the plurality of advertisements in a rotational fashion and enables the user to interact with the displayed advertisements.

As admitted in the Office Action, Wynblatt does not teach "wherein the device displays the plurality of advertisements in a rotational fashion," as recited in claim 31. As described above, Wynblatt merely teaches transmitting a URL to mobile information terminals that are passing by. Wynblatt does not relate to the display of a plurality of advertisements, much less to displaying the plurality of advertisements in a rotational fashion. Contrary to the assertion in the Office Action, a motivation to modify Wynblatt to include "wherein the device displays the plurality of advertisements in a rotational fashion" is not present. Therefore, Wynblatt does not teach or suggest each and every element of claim 31.

Thus, for at least this reason, claim 31 is patentable over Wynblatt. Furthermore, independent claim 36 is also patentable over Wynblatt for at least these reasons, and further in view of its own features. Furthermore, dependent claims 32-35 and 37-40, which depend from claims 31 and 36, respectively, are also patentable over Wynblatt for at least these reasons, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 32-35 and 37-40 be reconsidered and withdrawn.

Applicants note that the Examiner took "Official Notice" that the concepts and the advantages of the elements and limitations of claims 32-35 (page 12 of the Office Action) and claims 37-40 (page 12 of the Office Action) "were notoriously well known and expected in the art at the time of the invention" Applicants respectfully traverse these assertions of Official Notice by the Examiner.

Applicants have reviewed the statements in the Office Action regarding claims 32-35 and 37-40, and have found them unclear and unsupported. Applicants respectfully request that if these assertions are maintained in a next Office Action, that the Examiner clarify his remarks regarding the modification of Wynblatt, the reasons for the motivation thereof, and how they apply to claims 32-35 and 37-40, so that Applicants can have the opportunity to timely respond. Applicants also respectfully request that the Examiner provide documentary evidence in the next Office Action to support his assertion of Official Notice if the assertion is to be maintained, as required in M.P.E.P. § 2144.03(C.). See 37 C.F.R. § 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

Claims 41-45

The Office Action fails to establish a *prima facie* case of obviousness for at least the reason that Wynblatt fails to teach each and every feature of claim 41. (M.P.E.P. § 2143). Wynblatt is very different from the claimed embodiments of the present invention. Claim 41, as amended, is shown below:

41. A method for displaying advertisements on a mobile device, comprising the steps of:
(1) identifying one or more advertisements upon the occurrence of a trigger from a trigger source;
(2) selecting advertisements based on the trigger; and
(3) enabling the display of the selected advertisements on said mobile device and the interaction of a user with the displayed advertisements.

As described above, Wynblatt teaches a local agent 28 (such as a billboard) that transmits a URL to mobile information terminals (*see* Abstract; *see also* col. 2, lines 35-48). Wynblatt states the system "provides drive-by-access" (col. 2, lines 26-27). Wynblatt does not teach or suggest identifying one or more advertisements upon the occurrence of a trigger from a trigger source, and selecting advertisements based on the trigger, as recited in claim 41. Wynblatt merely teaches transmitting a URL to mobile information terminals that are passing by. Thus, Wynblatt has no need for identifying or selecting advertisements based on a trigger, it merely transmits the URL - no identifying or selecting of advertisements occurs. Therefore, Wynblatt does not teach or suggest each and every element of claim 41.

Thus, for at least this reason, claim 41 is patentable over Wynblatt. Furthermore, dependent claims 42-45, which depend from claim 41, are also patentable over Wynblatt for at least these reasons, and further in view of their own features. Accordingly,

Applicants respectfully request that the rejection of claims 41-45 be reconsidered and withdrawn.

Applicants note that the Examiner took "Official Notice" that the concepts and the advantages of the elements and limitations of claims 42-45 (pages 13-14 of the Office Action) "were notoriously well known and expected in the art at the time of the invention" Applicants respectfully traverse these assertions of Official Notice by the Examiner.

Applicants have reviewed the statements in the Office Action regarding claims 42-45, and have found them unclear and unsupported. Applicants respectfully request that if these assertions are maintained in a next Office Action, that the Examiner clarify his remarks regarding the modification of Wynblatt, the reasons for the motivation thereof, and how they apply to claims 42-45, so that Applicants can have the opportunity to timely respond. Applicants also respectfully request that the Examiner provide documentary evidence in the next Office Action to support his assertion of Official Notice if the assertion is to be maintained, as required in M.P.E.P. § 2144.03(C.). *See* 37 C.F.R. § 1.104(c)(2). *See also Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test).

Conclusion

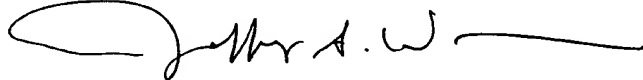
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the

outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Jeffrey S. Weaver", with a long horizontal flourish extending to the right.

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